

PATENT APPLICATION

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of

Docket No: Q62027

Sang-hyun SHIN

Appln. No.: 09/774,008

Group Art Unit: 2154

Confirmation No.: 2294

Examiner: Ashokkumar B. PATEL

Filed: January 31, 2001

For: IP-BASED COMMUNICATION SYSTEM BETWEEN TERMINALS AND METHOD
THEREOF

REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 41.41, Appellant respectfully submits this Reply Brief in response to the Examiner's Answer dated October 31, 2007.¹ Entry of this Reply Brief is respectfully requested.

Table of Contents

STATUS OF CLAIMS	2
GROUND OF REJECTION TO BE REVIEWED ON APPEAL	3
ARGUMENT	4
CONCLUSION	8

¹ Appellant submits that a mail copy of the Examiner's Answer was not received by the Appellant. The IFW for the present application indicates that the mailed Examiner's Answer was returned to the PTO as undelivered. To check on the status of the Appeal, Appellant checked PAIR and then first became aware of the Examiner's Answer on December 26, 2007.

STATUS OF CLAIMS

Claims 1-9, 12 and 15-18 are all the claims pending in the application.

Claims 1-9, 12 and 15-18 remain rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication No. 2002/0006803 (hereinafter "Mendiola").

Claims 1-9, 12 and 15-18, which have been at least twice rejected, are the claims on appeal (See Claims Appendix).

GROUNDΣ OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-9, 12 and 15-18 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication No. 2002/0006803 (hereinafter “Mendiola”).

ARGUMENT

In the Appeal Brief, the Appellant argued that Mendiola fails to disclose the claimed IP address and that the UIN, the Unique Identification Number, of Mendiola does not correspond to the claimed IP address of claim 1.

In response, Appellant respectfully submits that the Examiner's Answer still fails to point out how Mendiola discloses the claimed IP address to anticipate claim 1.

First, the Examiner cites Fig. 4 of Appellant's specification:

Applicant's Specification page 7, lines 7-11 and related Fig. 4 state the following:

"FIG. 4 shows an embodiment of the database 350 of FIG. 3. Referring to FIG. 4, the IP address for the telephone number "031-999- 1234" of the terminal 210 is registered as "167-234-34-123," whereas an IP address for the telephone number of the other terminal 270 is not registered."

FIG. 4

TELEPHONE NUMBER	IP ADDRESS
031-999-1234	167-234-34-123
031-234-4567	
031-345-5679	

Having learned what the Applicant's Specification states, the following is the teachings of Mendiola:

See pg. 15 of Examiner's Answer.

While the Appellant concedes that the Examiner has accurately recited the Appellant's disclosure, the Examiner has not shown how the Appellant's specification is relevant in showing how the claim recitations are disclosed by the teachings of Mendiola.

Appellant notes that claim 1 is rejected under 35 U.S.C. § 102(e) which require that the cited prior art be of another. In contrast, the sections of the specification cited by the Examiner are not of another, but are of the Appellant, and, therefore, cannot qualify as 102(e) art.

Second, the remaining sections of the Examiner's Answer on pages 16-21, continue to cite Mendiola, yet, still do not point out where the claimed IP address is disclosed.

Mendiola discloses that the UIN is basically a GSM mobile phone number. For example, if one's GSM mobile phone number is 639175336647, then the UIN is 639175336647. See paragraphs 0070 and 0072.

IP addresses are commonly known by one skilled in the art to be four numbers, where each of the four numbers are separated from others of the four numbers. Each of the four numbers range from 0 to 255. In contrast, the UIN number disclosed by Mendiola is a series of numbers with no separation between four numbers, as would be required for an IP address.

Third, if the Examiner is trying to argue that Mendiola inherently discloses the use of IP addresses as claimed, the Examiner does not provide a line of reasoning to support such a position.

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." MPEP 2112(IV) quoting Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

Further, it is well established that "[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." Id. quoting In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir.

1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); see *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

The differences between the UINs and the IP addresses pointed out above show that the Examiner does not provide a basis in fact and/or technical reasoning to reasonably support the determination that the claimed IP address, i.e., an IP address corresponding to the second terminal, necessarily flows from the UIN of Mendiola.

In view of the above, Appellant respectfully submits the Examiner's statement that "based on the comparison with the Appellant's Specification and Mendiola's teachings, UNI [sic] is an IP address assigned to GSM Mobile clients," is entirely without support.

Lastly, the Appellant argued in the Appeal Brief that Mendiola fails to disclose (b) upon receipt of the request, checking whether an IP address corresponding to the second terminal is registered; and (c) if the IP address is not registered, assigning an IP address to the second terminal corresponding to information from an IP address server, in combination with other elements of the claim.

In response, the Examiner argues on pages 18-21 that Mendiola allegedly discloses the claimed (b) and (c).

Appellant respectfully submits that the Examiner still does not point out where Mendiola discloses (b) upon receipt of the request, checking whether an IP address corresponding to the second terminal is registered.

Additionally, Appellant submits that to anticipate a claim, “[t]he elements must be arranged as required by the claim” MPEP § 2131. Here, in the Examiner’s Answer, the Examiner argues that:

Mendiola, thus,

- 1) “allocates” unique identifier to said prospective user and match said unique identifier to the client specific address of the prospective user;
- 2) tentatively register an account for said prospective user;
- 3) then stores in the database the matched unique identifier and client specific access address under the unique identifier;
- 4) sends notification of said unique identifier to said prospective user at the client specific address of the prospective user, inviting registration of the prospective user if the initial sending was associated with a request to register from someone other than the prospective user.

Although it is not entirely clear from the Examiner’s Answer, it appears that the Examiner is arguing that:

- the “1) ‘allocates’ unique identifier” and “2) tentatively register,” in Mendiola corresponds to the “(c) . . . assigning an IP address to the second terminal,” of claim 1 and
- the “4) sends notification, inviting registration,” of Mendiola corresponds to the “(a) receiving a request for an IP address of the second terminal” of claim 1.

As shown above, Mendiola discloses a process which, according to the Examiner's argument as best understood by the Appellant, would be in the opposite order of what is recited in claim 1.

Therefore, since the disclosure of Mendiola corresponding to the claimed elements, are not laid arranged as recited by the claim, Appellant submits that claim 1 is further not anticipated.

CONCLUSION

For the above reasons as well as the reasons set forth in Appeal Brief, Appellant respectfully requests that the Board reverse the Examiner's rejections of all claims on Appeal. An early and favorable decision on the merits of this Appeal is respectfully requested.

Respectfully submitted,

/ S. Stuart Lee /

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

Seok-Won Stuart Lee
Registration No. 61,124

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: December 28, 2007